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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,344	11/26/2003	Christian Alexander Lang	YOR920030480US1	8235
7590 Ryan, Mason & Lewis, LLP 90 Forest Avenue Locust Valley, NY 11560				
11/13/2008				
EXAMINER				
VAUGHN, GREGORY J				
ART UNIT		PAPER NUMBER		
2178				
MAIL DATE		DELIVERY MODE		
11/13/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/723,344

Applicant(s)

LANG ET AL.

Examiner

GREGORY J. VAUGHN

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-11 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-11 and 16-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Action Background

1. This action is responsive to applicant's response filed 7/16/2008.
2. No claims are amended with this response. Claims 5 and 15 were previously canceled.
3. Claims 1-4, 6-14 and 16-19 are pending in the case; claims 1, 16, 17, and 18 are independent claims.
4. The examiner's rejection of claims 1-4, 6-14 and 16-19, rejected as described in the office action dated 4/16/2008 is withdrawn in view of the applicant's remarks, however, new grounds of rejection are made as described below.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4, 6-11 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al., US Patent 5,309,359, filed 8/16/1990, patented 5/3/1994 (hereinafter Katz) in View of Neal et al., US Patent 6,697,799, filed 10/24/2002, patented 2/24/2004 (hereinafter Neal).
7. **Regarding independent claim 1**, Katz is directed toward automatically and semi-automatically generating annotations to facilitate computer text retrieval (see abstract). Katz discloses matching a user proposed annotation to knowledge base of annotations and annotating the document with the allowed annotation. Katz recites: *"The basic feature of the invention is that selected subdivisions of the text, such as sentences, paragraphs, sections, chapters, articles, columns, or the like, are annotated"* (column 2, lines 42-45) and *"The annotations may be generated manually, semiautomatically or automatically"* (column 2, lines 54-55) and *"In another method for the semiautomatic generation of annotations, a database of annotation groups is formed from existing annotated subdivisions. One annotation*

for a current text is then selected, either by an operator or by some automatic technique" (column3, lines 3-7).

Katz discloses "*some automatic technique*" but fails to describe a first mode and a second mode as claimed. Neal is directed toward annotating items by classifying the items. Neal discloses automatically determining the annotation in Figure 4 at reference sign 21 (shown as "*Automatic Classification Knowledge Database*"). Neal discloses a first and second determining mode, where the annotation is selected by the user or automatically. Neal recites: "*The determination as to whether or not to automatically classify an item can be made using thresholds. The thresholds can be made configurable by a system manager depending upon the need for accuracy as balanced against the amount of operator interaction desired. In this approach, the confidence score at each search view is compare to a configurable threshold. If the score is above the threshold, then it is automatically classified. If it is below the threshold, then it is submitted to a user for human review and selection*" (column 11, lines 48-56).

Therefore, it would have been obvious, to one of ordinary skill, at the time the invention was made, to provide the mode selection as taught by Neal to the annotation process of Katz in order to decrease user intervention in the annotation selection process.

8. **Regarding dependent claim 2**, Katz and Neal disclose notifying the user that the user-proposed text does not match at least one allowed item when a match is

not found in Neal's Figure 2 at reference sign 114 (shown as "*Display Results (Even If 0 Found)*").

9. **Regarding dependent claim 3**, Katz and Neal disclose storing a user proposed text match when a match is found in Neal's Figure 3 at reference sign 51 (shown as "*Updated Classification Knowledge Database*").
10. **Regarding dependent claim 4**, Katz and Neal disclose notifying the user that the user proposed text matches more than one allowed item, when more than one match is found in figure 8 at reference sign 820 (shown as a list of a plurality of matches).
11. **Regarding dependent claim 6**, Katz and Neal disclose notifying the user of match results after each attempted matching operation in Figure 6C at reference sign 155 (shown as "*Present the Categories and Confidence score to a User*").
12. **Regarding dependent claim 7**, Katz and Neal disclose a predetermined number of matching operations in Figure 4 at reference sign 59 (shown as "*Search Method Definition*"), and wherein the figure discloses an exemplary number of 3 matching operations.
13. **Regarding dependent claims 8-10**, Katz and Neal disclose a history buffer of matches (claim 8), using the history buffer to update a set of allowed texts (claim 9) and using the history buffer to disambiguate matches (claim 10) in Neal's Figure 3 at reference sign 43 (shown as "*Classification Reference Database*"), 51 (shown as

"Updated Classification Knowledge Database") and 47 (shown as "Standards Database").

14. **Regarding dependent claim 11**, Katz and Neal disclose determining a closeness between the user-proposed text and the allowed text in Figure 4 at reference sign 75 (shown as *"Search Method Scoring Weights"*).
15. **Regarding independent claims 16, 17 and 18**, the claims are directed toward an apparatus, article of manufacture and a method, respectively, for the method of claim 1, and are rejected using the same rationale.
16. **Regarding dependent claim 19**, Katz discloses storing the user proposed annotation. Katz recites: *"annotations are originally presented in a natural language, they are preferably converted to a structured language form for storage"* (column 3, lines 17-19).
17. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz in view of Neal and in further view of Handschuh et al., S-CREAM – Semi-Automatic Creation of Metadata, copyright 2002 (hereinafter Handschuh).
18. **Regarding dependent claims 12-14**, Katz and Neal disclose obtaining a user proposed annotation, and automatically determining if the user-proposed annotation matches an allowed annotation from a knowledge base. Katz and Neal fail to disclose the knowledge base as a term graph. However Handschuh discloses the use of a term graph (claim 12), computing a distance between the user-proposed

annotation (in the form of a classification) and an allowed annotation (claim 13) and a stemming operation (claim 14) in the diagram at the top of page 4.

Therefore it would have been obvious, to one of ordinary skill at the time the invention was made, to combine the annotation system of Katz and Neal with the term graph of Handschuh, in order to calculate the degree of separation between the user-proposed term and the allowed term, which would indicate to a system user the allowability of the proposed term.

Response to Arguments

19. Applicant's arguments with respect to claims 1-4, 6-14 and 16-19 have been considered but are moot in view of the new ground(s) of rejection, as described above.

Conclusion

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Stephen S. Hong/
Supervisory Patent Examiner, Art
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/Gregory J. Vaughn/
Patent Examiner
November 10, 2008